

REMARKS

The description has been amended to correct minor informalities.

Patent Owner provisionally elects claims 1-37 and 44-55 in group I for further prosecution in this application should the requirement for restriction be maintained and the species of FIGS 4A-4I and claims 1-37 and 44-55 readable thereon should the requirement for restriction be maintained.

The requirement for restriction is respectfully traversed. 35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT.

M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the apparatus of Group I must be searched in connection with examining the process claims in the group II.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".

The Petition is GRANTED.

1. That claims 1-37 and 44-55 are drawn to an electromagnetic actuator and claims 38-43 are drawn to a method for controlling an electromagnetic valve actuator has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden. That the inventions are related precludes a ruling that the groups are independent and distinct. While the Examiner states that claims 38-45 are drawn to a method for controlling an electromagnetic valve, claims 38-43 actually claim a "method for controlling an electromagnetic valve actuator."

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the claimed electromagnetic actuator are likely to disclose subject matter which must be searched in connection with examining the six claims drawn to a method for controlling an electromagnetic valve actuator, only one of which is an independent claim. Surely examining these six claims in this application with the examination of the remaining forty nine claims in the elected group creates no serious burden. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule that the claims in each group are PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden.

2. The contention that no claim appears to be generic is incorrect. Claim 1 describes both the embodiment of FIGS.2A-2H and 4A-4I.

Both embodiments have a stator assembly having an inner surface that defines an opening, the stator assembly comprising, a coiled conductor disposed near the inner surface of the stator assembly wherein the coiled conductor is adapted to generate a first magnetic field when current is applied, a center pole formed of material having high magnetic permeability and having a longitudinal axis, and an armature assembly at least partially disposed within the stator assembly opening and comprising a permanent magnet, wherein the armature assembly moves in a direction parallel to the longitudinal axis of the center pole when current is applied to the coiled conductor assembly.

In view of the forgoing reasoning and authorities, withdrawal of the requirement for restriction is respectfully requested and an action on the merits of all the claims. In the absence of pertinent prior art all the claims are submitted to be in a condition for allowance, and notice


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thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Respectfully submitted,
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